REMARKS

Claims 84-87 have been canceled without prejudice. Claims 2, 3, 4, 5, 14, and 22 have been amended solely to refer to sequences listed in Figures and Tables by using a sequence identifier (i.e., SEQ ID NO). Claim 15 has been amended to correct a typographic error. No new matter has been introduced.

The Examiner acknowledges Applicants' election with traverse of Group I (claims 1-29 and 59-60) in the Reply filed on September 12, 2005. However, the Examiner asserts that this group is subject to a further restriction. Specifically, the Examiner alleges that "claims 1-29 and 59-60 are drawn to a nucleic acid inhibitor of EphB4 selected from the sequences listed in **Table 7** . . . Accordingly, applicants are required to elect a total of one (1) nucleic acid sequence from **Table 7**." See Office Action, page 2, lines 4-13 (emphasis added).

First of all, Applicants respectfully submit that the Examiner has mischaracterized the claimed invention. Independent claim 1 is directed to an isolated nucleic acid compound comprising at least a portion that hybridizes to an EphB4 transcript under physiological conditions and decreases the expression of EphB4 in a cell. The claimed nucleic acid compounds clearly include both antisense nucleic acids such as the sequences listed in Table 6 (see claim 14) and RNAi constructs such as sequences listed in Table 7 (see claim 22). Thus, contrary to the Examiner's assertion, Applicants' invention is not limited to the sequences listed in Table 7.

Further, for the reasons below, Applicants believe that the Restriction Requirement would be improper if the Restriction is not interpreted as requiring Applicants to elect a species nucleic acid for *search purpose* only. Applicants hereby elect *with traverse*, and *for search purpose only*, the sequence as set forth in SEQ ID NO: 231 (EphB4 AS-10, listed in Table 6). Presently, claims 1-9, 11-17, 26-29, and 59-60 read on the elected species.

Applicants traverse this sequence election requirement on the basis that Applicants are claiming a *genus* of nucleic acid compounds that decrease the expression of EphB4 in a cell (e.g., antisense nucleic acids and siRNA constructs), rather than a *species* nucleic acid compound selected from the claimed genus. The independent *genus* claims (*e.g.*, claim 1) does not recite any specific nucleic acid *species*. Thus, it is inappropriate for the Examiner to

restrict the claimed invention to an un-recited *species* in a *genus* claim, because doing so amounts to using Restriction Requirement to limit the scope of independent claims that have not yet been examined on merits. Applicants note that the statutory basis for restriction practice arises under 35 U.S.C. § 121, which authorizes the patent office to require that each patent application be limited to a single invention. However, there is no basis in the statute or the rules (37 C.F.R. §§ 1.141 and 1.142) for the patent office to eliminate inventions from consideration entirely. A genus invention is as much an invention as each species. Thus, when the Examiner enumerates the various inventions that Applicants are requested to choose between, the Examiner is not authorized to omit the generic inventions.

Applicants submit that the Examiner's requirement to elect one nucleic acid sequence is too restrictive. Applicants note that MPEP § 803.04 states that "to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application." The MPEP goes on to state that "it has been determined that normally ten sequences constitute a reasonable number for examination purposes." Thus, Applicants are at least entitled to elect ten sequences for examination purposes.

Applicants also submit that there is no undue search burden on the Examiner to perform a search to cover the scope of the independent claims. Although there can be many choices for the nucleic acid compounds, all nucleic acid sequences share the same generic feature, i.e., comprising at least a portion that hybridizes to an EphB4 transcript under physiological conditions and decreases the expression of EphB4 in a cell. Therefore, a search using generic claim terms (such as "hybridize to EphB4," "decrease EphB4 expression," "antisense" and/or "siRNA," etc.) would necessarily encompass a broad search that can adequately cover the claimed subject matter. Pursuant to MPEP 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Thus, no serious search burden will result if the Restriction Requirement is withdrawn.

Applicants note that all claims are generic claims linking elected and non-elected species. Pursuant to MPEP 809.04, "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141 (MPEP 809.02(a)).

The burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the election requirement and request a search and examination of the genus of the nucleic acid sequences claimed herein.

In response to the Examiner's assertion that "claim 22 improperly refers to sequences in tables" (Office Action, the paragraph bridging pages 2 and 3), Applicants have amended claims 2, 3, 4, 5, 14, and 22 to refer to sequences listed in Figures and Tables by using a sequence identifier (i.e., SEQ ID NO), thereby overcoming the objections.

CONCLUSION

This response is accompanied by a request for a two-month extension of time and appropriate fees. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 18-1945, under Order No. VASG-P01-001.

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Respectfully submitted,

By_____

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